

## **REMARKS**

In the Office Action dated December 1, 2009, the Examiner rejected all claims under 35 USC 112, first paragraph as failing to comply with the written description requirement, rejected claims 1-2, 7-9, 13-16 and 19-21 under 35 USC 102(b) as anticipated by US Patent Publication No. 2004/0117315A1 to Cornuejols ("Cornuejols"), rejected claims 1-4, 6-11 and 13-21) under 35 U.S.C. 103(a) as being unpatentable over the combination of Lin et al. (US 6,122,663) ("Lin et al.") and Heckerman et al. (US 2004/00832270) ("Heckerman et al."), and rejected claims 3-4, 6, 10-11 and 17-19 under 35 U.S.C. 103(a) as being unpatentable over the combination of Cornuejols and Heckerman et al.

Claims 1, 8 and 15 have been amended. Claims 1-4, 6-11 and 13-21 are currently pending. No new matter has been introduced.

### **I. Rejection of Claims 1, 8 and 15 under 35 USC 112, first paragraph**

The Examiner rejected claims 1, 8 and 15 under 35 USC § 112, first paragraph as failing to comply with the written description requirement. The Examiner asserted that the limitation "without regard as to whether there is available memory for storing at least one additional record or the amount of time the one or more records has been stored" was not adequately described in the specification to show that the applicant had possession of the claimed invention. In order to speed consideration of the claims, claims 1, 8 and 15 have been amended to remove that limitation.

Applicant requests that the rejection of claims 1, 8 and 15 under 35 U.S.C. 112, first paragraph be withdrawn.

### **II. Rejection of Claims 1-2, 7-9, 13-16 and 19-21 under 35 USC 102(b)**

The Examiner has rejected claims 1-2, 7-9, 13-16 and 19-21 under 35 § USC 102(b) as anticipated by US Patent Publication No. 2004/0117315 A1 to Cornuejols. ("Cornuejols"). It is respectfully submitted that claims 1-2, 7-9, 13-16 and 19-21 are not anticipated by Cornuejols because Cornuejols does not teach all the limitations of Claims 1-2, 7-9, 13-16 and 19-21, in view of the limitations of claims 1, 8 and 15.

All of the independent claims 1, 8, and 15 as amended require that records on a local memory be stored and filed on a central database in response to an instruction to file

by the user of the remote computer. Furthermore, all of claims 1, 8, and 15 require that the same record that is filed and stored on the remote database is identical to the record that is deleted from the local memory by the processor.

Cornuejols teaches a software system that acts in response to an operating system of a terminal. The system detects when a web site, such as an e-commerce site, is being visited by a user of a terminal. The software creates a page trace of site trace file for websites that are visited by a user at a terminal. When the user visits a site (one from a list of domain names maintained at a separate database), the software creates a site trace of the user's activities at the site, so that the user can later retrace his interaction with that website. Cornuejols, para. 0106. The tracking of the web site, and the maintenance of the page trace are all maintained at the user's terminal. Cornuejols, para. 0034. The site traces, which are the records created by the system, are maintained on the user's terminal, and are neither filed nor stored with a database.

In the Cornuejols reference, the only information transmitted to a database are data relating to web sites visited, and information relating to the customer's experience at that site. Cornuejols, para. 0190. The page trace record that is created by the client computer program of Cornuejols is not stored or filed with a database, but rather on the permanent memory associated with a terminal. While some information may be transmitted to a database, it is not the identical record (the page trace) that is created on the client's terminal.

Furthermore, the site trace records created by the program of Cornuejols are not deleted in response to an instruction to file the record from the user and upon storage of the identical record to the database, but only on certain conditions (length of time on file, or when a memory limit is reached) that is determined by the software. Cornuejols, paras. 0124, 0243. Therefore, the filing and deleting of Cornuejols takes place independently, not in response to, any user instruction to file a record.

Cornuejols does not teach all of the elements of claims 1, 8, and 15 and does not anticipate claims 1, 8, and 15. Claims 2, 7, 9, 13, 14, 16, and 19-21 are also not anticipated by Cornuejols for these reasons and on their own merits. Therefore, it is respectfully requested that the rejection be withdrawn.

### **III. Rejection of Claims 1-4, 6-11, 13-21 under 35 USC 103(a)**

The Examiner has rejected claims 1-4, 6-11, 13-21 under 35 USC 103(a) as obvious over Lin et al. in view of Heckerman et al. and rejected claims 3-4, 6, 10-11 and 17-19 under 35 U.S.C. 103(a) as being unpatentable over the combination of Cornuejols and Heckerman et al. (Lin et al., Heckerman et al. and Cornuejols are collectively referred to as the "References"). It is respectfully submitted that claims 1-4, 6-11, 13-21 are not rendered obvious by the References because the neither of the combinations of the References as suggested by the Examiner teach all the limitations of Claims 1-4, 6-11, 13-21 in view of the limitations of claims 1, 8 and 15 from one of which each of the rejected claims depend.

In order to establish a prima facie case of obviousness "all of the claim limitations must be taught or suggested by the prior art." In re Royka, 490 F.2d 981 (C.C.P.A. 1974). "If an independent claim is not obvious under 35 U.S.C. §103, then any claim depending therefrom is not obvious." MPEP 2143.03 (citing In re Fine, 837 F.2d 1382, 1385 (C.C.P.A. 1970)).

#### **a. Claims 1-4, 6-11, 13-21 are Patentable over Lin in View of Heckerman**

Neither Lin nor Lin in combination with Heckerman teach or suggest all of the elements of independent claims 1, 8 and 15. In particular, neither reference teaches

In the present invention, whether or not a record (such as a document) is filed and stored to a database and subsequently deleted is in the hands of the user of the remote computer. The user enters an instruction into the filing system software to classify and then file a record. In response, the record and its classification are stored at the central database, and the record and its classification are deleted from the remote computer.

Lin, by contrast, discloses a time record management program that is run entirely independently of the user. The software responds to information from the operating system relating to whether certain applications requiring timing are running. The time record software prepares an application record on the local computer concerning the running of that application, and in response to a signal from the operating system that an

application has ended, transmits information extracted from that record (such as the start time and the end time) to a remote database. The information transmitted to a database is not identical to the application record of the site visit that is created on the local computer (an extensive record described at cols. 7-8 of Lin), but rather simply the start time and end time and a transaction identification. Lin, col. 5, ll. 45-48. The time record software may then delete the application record, once the application is no longer running.

Furthermore, of Lin does not disclose that the application record on the local computer is filed and stored in response to a user command to file a record. The steps of recording the start time and end time are carried out automatically as a result of the closing of an application, whether or not the user enters a command to file the time record. The user or a remote computer does not control what records are stored to a remote database, and what records are deleted from the local computer.

The addition of Heckerman does not remedy the shortcomings of Lin as a reference, because Heckerman does not teach a system or method for storing and filing a classified record to a central database in response to a user instruction to file a record, nor does it teach that such a system or method delete the identical record from a local memory in response to the same user instruction.

Therefore, Applicant avers that independent claims 1, 8, and 15 are patentable over Lin in view of Heckerman, because neither reference discloses filing and storing a record to a database in response to a user command at a remote computer, and neither Lin nor Heckerman disclose deleting the identical record(s) from the remote computer as a result of the user's command to file. Claims 2-4, 6-7, 9-11, 13-14, and 15-21, being dependent from claims 1, 8, or 15, are patentable for these reasons and on their own merits. Applicant requests that these rejections be withdrawn.

**b. Claims 3-4, 6, 10-11 and 17-19 are Patentable over Cornuejols in view of Heckerman**

As discussed in Section II., above, Cornuejols does not teach or suggest all of the limitations of independent claims 1, 8, and 15. The addition of Heckerman does not remedy the shortcomings of Cornuejols as a reference, because Heckerman does not

teach a system or method for storing and filing a classified record to a central database in response to a user instruction to file a record, nor does it teach that such a system or method delete the identical record from a local memory in response to the same user instruction.

Therefore, it is respectfully requested that the rejections over Cornueujols and Heckerman be withdrawn.

### **CONCLUSION**

For at least all of the foregoing reasons, it is respectfully submitted that claims 1-4, 6-11 and 13-21 as amended are allowable. Favorable reconsideration and allowance of this Application is therefore respectfully requested. Applicants hereby request pursuant to 37 CFR 1.136(a) a three month extension of time , rendering this response timely upon the granting of the extension of time. The fee for the three month extension of time, is paid by deposit account 09-0007. The Director is hereby authorized to charge any other fees which may be required, or credit any overpayment, to Deposit Account Number 09-0007. If applicants have inadvertently overlooked the need to petition for any additional extension of time or to pay an additional fee, Applicants conditionally petition therefore, and authorize any fee deficiency to be charged to deposit account 09-0007. When doing so, please reference the above-listed docket number.

Respectfully submitted,

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